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RICHER, AARON M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/942,761

Applicant(s)

MCCARTHY ET AL.

Examiner

AARON M. RICHER

Art Unit

2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-11, 33, 34, 36-39, 46, 48-50, 52, 53, 55 and 57-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-11, 33, 34, 36-39, 46, 48-50, 52, 53, 55 and 57-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed October 30, 2008 have been fully considered but they are not persuasive.
2. Applicant argues, in reference to the objection to the specification, that the term "computer-readable media" is supported by the specification and is well-known in the art. However, examiner notes that "computer-readable media" could read on any number of media, both tangible (such as CDs and flash memory) and intangible (such as a signal). Without any guidance from applicant's specification, examiner cannot determine what kind of media would be encompassed by the term. See MPEP 608.01(o), which clearly states that "The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import".
3. Applicant's arguments with respect to claims 1, 2, 4-11, 33, 34, 36-39, and 46, 48-50, 52, 53, 55, 57, and 58-67 have been considered but are moot in view of the new ground(s) of rejection.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no explanation of what comprises "computer readable media" as is claimed in claims 58 and 59.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 6, 7, 11, 58, 59, and 63 are rejected under 35 U.S.C. 102(b) as being anticipated by Deo (U.S. Patent 5,973,612).

7. As to claim 1, Deo discloses a method comprising:

receiving at a communication terminal from a remote terminal via a communication network a profile message (col. 2, lines 29-47; col. 10, lines 50-57; col. 13, lines 28-49; a sender specifies characteristics associated with how a terminal should alert a user to an incoming page);

parsing the received profile message to identify a plurality of profile fields corresponding to terminal operating characteristics, wherein the profile message comprises at least two profile fields that correspond to any of the following: a ringing tone field, a ringing volume field, an incoming call alert field, a message alert tone field, a keypad tone field, a warning tone field, or a graphic field (col. 11, lines 25-51; fields exist *corresponding to* a ringing tone as well as a visual, which could read on an "incoming call alert field" or a "graphic field"; col. 12, lines 1-45 disclose the parsing of fields and the examples following are examples of how those parsed fields are interpreted);

storing information corresponding to the plurality of profile fields in the communication terminal (col. 12, lines 1-67; information corresponding to profile fields is stored in variables such as Object.NotifyMask.Visual, Object.NotifyMask.AudioIndex);

identifying one or more user profiles stored in the communication terminal, wherein each of the user profiles corresponds to a set of user preferences and settings that control the operation of the communication terminal (col. 2, lines 29-47; col. 10, lines 50-57; col. 11, lines 14-18; col. 11, line 64-col. 12, line 15; a user sets up profiles that determine how a terminal should operate when certain objects are received);

associating the group of terminal operating characteristics with a first user profile in the communication terminal (col. 10, lines 50-57; col. 11, lines 14-18; col. 11, line 64-col. 12, line 15; the incoming object is associated with a folder that describes the incoming object; the incoming characteristics are compared with a user-selected notification profile, reading on an association);

and configuring the communication terminal to operate according to the received plurality of profile fields (col. 14, lines 6-12; a user may set up a profile to allow the received operating characteristics to control the device).

8. As to claim 2, Deo discloses a method wherein the received plurality of profile fields includes a ringing tone and at least one graphical picture (col. 2, lines 48-56; audible alarm signals and melodies read on ringing tones, while a flashing indicator reads on a graphical picture).

9. As to claim 6, Deo discloses a method wherein the profile message is received from a remote server providing promotional content (col. 10, line 64-col. 11, line 5; a

remote provider automatically sends information regarding stock events; given that the term "promotional content" is very broad, it can be read as any event that promotes a product, and in this case, it is stock that is being promoted).

10. As to claim 7, Deo discloses a method wherein the message is received from a remote server providing event driven content (col. 10, line 64-col. 11, line 5; a remote provider automatically sends information regarding stock events).

11. As to claim 11, Deo discloses a method wherein the profile message includes a profile name label for the group of terminal operating characteristics (col. 8, lines 27-50; each group of characteristics has an associated "cap code" that labels the type of data being sent).

12. As to claim 55, Deo discloses a method wherein configuring the communication terminal comprises creating a new user profile on the communication terminal based on the plurality of received profile fields (col. 10, lines 50-57; col. 11, lines 14-18; col. 11, line 64-col. 12, line 15; the combination of incoming characteristics and current set characteristics reads on a new profile).

13. As to claim 58, see the rejection to claim 1.

14. As to claim 59, see the rejection to claim 2.

15. As to claim 63, Deo discloses a method wherein the plurality of profile fields comprises a first field identifier corresponding to a first data type, and a second field having a second field identifier corresponding to a second different data type (col. 12, lines 50-60).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claims 4, 8, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deo in view of Smith (U.S. Patent 6,226,367).

19. As to claim 4, Deo does not disclose a method wherein the plurality of profile fields includes at least one of a card defining contact information and a calendar note defining a date of an event. Smith, however, does disclose such information being stored (col. 10, lines 47-52; an electronic business card, or EBC, with contact information is stored). The motivation for this is to allow a user to take full advantage of caller ID and contacts functions (col. 2, lines 24-39). It would have been obvious to one skilled in the art to modify Deo to store an electronic business card in order to enhance caller ID and contacts functions as taught by Smith.

20. As to claim 8, Smith discloses a method comprising providing a display on the communication terminal allowing the user to discard one of more of the terminal operating characteristics from a received profile message after inspecting the plurality of profile fields included in the profile message (col. 10, lines 47-52; an option for storing an EBC is presented; if a user chooses not to store an EBC, the EBC is not saved and therefore discarded). Motivation for the Deo-Smith combination is given in the rejection to claim 4. It is noted that this feature further enhances the caller ID and contacts functions of a cellular phone/PDA/pager.

21. As to claim 46, Smith discloses a method comprising:

after receiving the profile message, providing a display on the communication terminal to notify a user of the receipt of the profile message (col. 10, lines 40-52; characteristics such as an icon are displayed, alerting a user to new characteristics received);

and receiving at the communication terminal user input indicating that the received profile message is to be saved on the communication terminal (col. 10, lines 47-52; an option for storing an EBC is presented; if a user chooses not to store an EBC, the EBC is not saved and therefore discarded). Motivation for the Deo-Smith combination is given in the rejection to claim 4. It is noted that this feature further enhances the caller ID and contacts functions of a cellular phone/PDA/pager.

22. Claims 5, 9, 33, 34, 37-39, 49, 53, 57, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deo in view of Park (U.S. Patent 7,158,805).

23. As to claim 5, Deo does not disclose that the plurality of profile fields includes bookmark information defining the location of a server document associated with a user-selectable profile. Park, however, discloses an update system with information such as a home page address (col. 9, see information item 10). It would have been obvious to one skilled in the art to modify Deo to include a server document address as received information as taught by Park as this is simply combining a new piece of information into the structure of Deo. The invention of Deo would still perform the same way, but would display and store a document address instead of a tone or visual. One skilled in the art would recognize this as keeping in the spirit of Deo's invention, while substituting one piece of data for another.

24. As to claim 9, Park discloses a method of creating an animation associated with a user-selectable profile with a plurality of individual pictures (col. 9, see information item 16 "moving picture"). See the rejection to claim 5 for the rationale of the Deo-Park combination. It is submitted that the same rationale applies to this claim, as an animation is just another piece of identifying data to be received.

25. As to claim 33, see the rejection to claim 1.

Deo does not disclose updating the set of user preferences and settings of a first user-selectable profile to correspond to the received plurality of profile fields. Rather, Deo has preset user characteristics that are set to allow or disallow remotely sent characteristics to be used, but does not allow for *storing a change* in the actual user profile. Park, however, discloses updating of contact information (col. 3, line 47-col. 4, line 3; col. 4, lines 13-29; information such as office email address and phone number is

stored), which can read on updating the operating characteristics (phone numbers to be dialed, etc.) of a profile. The motivation for updating automatically is to take away the burden on a user to update the information himself (col. 1, lines 41-49). It would have been obvious to one skilled in the art to modify Deo to automatically update in order to reduce burden on a user as taught by Park.

26. As to claim 34, see the rejection to claim 2.

27. As to claim 37, see the rejection to claim 5.

28. As to claim 38, see the rejection to claim 6.

29. As to claim 39, see the rejection to claim 7.

30. As to claim 49, see the rejections to claims 1 and 33.

31. As to claim 53, see the rejection to claim 2.

32. As to claim 57, see the rejection to claim 55.

33. As to claim 67, see the rejection to claim 63.

34. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Deo in view of Park and further in view of Tran (U.S. Publication 2022/0069220).

35. As to claim 10, neither Deo nor Park discloses producing a screen saver from an animation upon selection of a user-selectable profile. Tran, however, discloses a mobile terminal (p. 5, section 0060) that downloads news clips and animates them as a news ticker to be used when the mobile terminal is inactive, thus acting as a screen saver (p. 17, section 0142). It would have been obvious to one skilled in the art to modify Deo and Park to display a screen saver of received information as taught by Tran as this is simply combining pieces of data into an animation as is known in the art.

The invention of Deo would still perform the same way, but would use icons or pictures in succession to create a screen saver instead of just displaying a single flashing indicator. One skilled in the art would recognize this as keeping in the spirit of Deo's invention, while substituting one piece of data for another.

36. Claims 36, 48, 50, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deo in view of Park as applied to claim 33 above, and further in view of Smith.

37. As to claim 36, see the rejection to claim 4.

38. As to claim 48, see the rejection to claim 46. Neither Deo nor Smith discloses that profiles are to be updated, but Park does disclose this as stated in the rejection to claim 33.

39. As to claim 50, see the rejection to claim 46.

40. As to claim 52, see the rejection to claim 8.

41. Claims 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deo in view of Beaton (U.S. Patent 6,442,263).

42. As to claim 60, Deo does not expressly disclose using SMS messages as profile messages. Beaton, however, does disclose using SMS messages to transfer profile data, such as EBC (electronic business card) data (col. 11, lines 12-21). The motivation for using SMS in this manner is that SMS is an error-free, guaranteed delivery system for point-to-point messages (col. 4, line 58-col. 5, line 13). It would have been obvious for one skilled in the art to modify Deo to use SMS to transfer profile information in order to guarantee delivery as taught by Beaton.

43. As to claim 61, Beaton discloses a method wherein the profile message comprises a plurality of concatenated SMS messages (col. 4, line 58-col. 5, line 13; profile messages too large for one SMS message can be concatenated into multiple messages).

44. As to claim 62, Beaton discloses a number of fields for EBC data (see fig. 18b for instance) in an SMS, but does not disclose how they would be separated. While the claim recites using "line feed characters" to separate, it is noted by examiner that there is no disclosed criticality in applicant's specification to using such characters to separate fields. It is noted by examiner that the choice of a line feed character appears to be a matter or design choice and that the invention would perform just as well using some other character as a separation character.

45. Claims 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deo in view of Park in view of Beaton.

46. As to claims 64-66, see the rejections to claims 60-62. The motivation for combining Beaton with Deo and Park is similar to the motivation for combining Beaton with Deo described above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON M. RICHER whose telephone number is (571)272-7790. The examiner can normally be reached on weekdays from 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee Tung can be reached on (571) 272-7794. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron M Richer/
Examiner, Art Unit 2628
12/23/08